

KELLEY DRYE & WARREN LLP

A LIMITED LIABILITY PARTNERSHIP

101 PARK AVENUE

NEW YORK, NEW YORK 10178

(212) 808-7800

FACSIMILE

(212) 808-7897

www.kelleydrye.com

WASHINGTON, DC
TYSONS CORNER, VA

LOS ANGELES, CA

CHICAGO, IL

STAMFORD, CT

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U.S. Patent & TMO/TM Mail Rcpt. Dt. #57



08-08-2002

DIRECT LINE: (212) 808-5127 EMAIL:
mgram@kelleydrye.com

August 8, 2002

VIA EXPRESS MAIL

Box TTAB- NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Galleon, S.A. v. Havana Club Holding, S.A., Cancellation No. 24,108

Dear Sir/Madam:

Pursuant to the Board's Order dated May 13, 2002 in connection with the above-referenced proceeding, we enclose a copy of the United States Court of Appeals for the Federal Circuit's Order dated July 31, 2002 granting the Director of the United States Patent and Trademark Office's motion to dismiss Appeal No. 02-1289.

Kindly acknowledge receipt of same by stamping and returning the enclosed self-addressed postcard.

Sincerely,

Michelle M. Graham

Enclosure

cc: John M. Whealan, Esq.
Charles S. Sims, Esq.
Michael Krinsky, Esq.

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NOTE: Pursuant to Fed. Cir. R. 47.6, this order
is not citable as precedent. It is a public order.

United States Court of Appeals for the Federal Circuit

02-1289

GALLEON, S.A. (now known as Bacardi & Company, Ltd.)
and BACARDI-MARTINI U.S.A., INC. (now known as Bacardi USA, Inc.),

Appellants,

v.

James E. Rogan,
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,

Appellee.

ON MOTION

Before LOURIE, GAJARSA, and LINN, Circuit Judges.

LOURIE, Circuit Judge.

ORDER

The Director of the United States Patent and Trademark Office moves to dismiss the appeal filed by Galleon, S.A. and Bacardi-Martini U.S.A., Inc. (Bacardi) for lack of jurisdiction. Bacardi opposes. The Director replies. Additionally, parties that were initially included in this court's official caption object to their inclusion in the official caption.

This case has an unusual history. Havana Club Holding, S.A. and Havana Club, International, S.A. (Havana Club) sued Bacardi in the United States District Court for the Southern District of New York for trademark infringement. Bacardi counterclaimed for cancellation of the mark. At the same time, there was pending before the PTO a

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cancellation proceeding filed by Bacardi concerning the same trademark. The PTO cancellation proceeding was stayed pending disposition of the court action.

The district court determined that alleged assignments of the trademark to Havana Club, by Empresa Cubana Exportadora De Alimentos Y Productos Varios trading as Cubaexport (Cubaexport), were invalid and void ab initio. The district court stated that "Cubaexport retained whatever rights it had in said mark and the related U.S. Registration as of said date, notwithstanding the invalid transfers." The district court denied Bacardi's request for cancellation because Cubaexport was not a party to the litigation. Havana Club Holdings, S.A. v. Galleon S.A., 974 F.Supp. 302 (S.D.N.Y. 1997). The district court informed the PTO of its determination concerning the invalidity of the assignments, pursuant to 15 U.S.C. § 1119, but stayed operation of that partial judgment pending appeal. The district court's judgment was affirmed by the United States Court of Appeals for the Second Circuit. Havana Club Holding, S.A. v. Galleon S.A., 203 F.3d 116 (2d Cir. 2000), cert. denied, 531 U.S. 918 (2000).

Thereafter, Bacardi notified the PTO that the stay, pending appeal, of the district court's judgment should be lifted. The PTO issued an order directing the parties to show cause why the records concerning the trademark should not be rectified to reflect the district court's judgment concerning the invalid assignments. After considering the parties' responses, the PTO on January 15, 2002 issued a "Notice" stating that the PTO's records would be rectified to reflect the district court's order. Bacardi filed an appeal from that notice, seeking review in this court.

Our review of decisions concerning trademarks is limited. We have jurisdiction, *inter alia*, to review decisions of the Trademark Trial and Appeal Board with respect to

applications for registration of marks, cancellation proceedings, and opposition proceedings. See 15 U.S.C. § 1071; 28 U.S.C. § 1295(a)(4)(B). Bacardi argues that this appeal should be treated as an appeal of a decision in a cancellation proceeding, although the cancellation proceeding initiated by Bacardi is pending. Bacardi asserts that, by issuing the order to show cause, the PTO initiated a cancellation proceeding and, essentially, denied cancellation because the PTO apparently did not rectify its records to satisfy Bacardi. We are not persuaded by this argument.*

Bacardi also argues that the court could treat its appeal as a petition for writ of mandamus. However, in the papers submitted, Bacardi has shown no entitlement to a writ of mandamus. Bacardi may, of course, appeal from any adverse decision of the TTAB after the TTAB issues a final decision in Bacardi's cancellation proceeding.

Accordingly,

IT IS ORDERED THAT:

- (1) The Director's motion to dismiss is granted.
- (2) Each side shall bear its own costs.
- (3) The reformed caption is reflected above.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JUL 31 2002

JAN HORBALY
CLERK

FOR THE COURT

JUL 31 2002

Date



Alan D. Lourie
Circuit Judge

cc: William R. Golden, Jr. Esq.
John M. Whealan, Esq.
Charles S. Sims, Esq.

* We express no opinion whether there would be jurisdiction to challenge the notice in a district court pursuant to the Administrative Procedure Act.

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ISSUED AS A MANDATE: JUL 31 2002